



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,276	11/26/2003	Shunji Aoki	4710-0104P	5459

2292 7590 12/28/2005

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
----------	--------------

1712

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/721,276

Applicant(s)

AOKI, SHUNJI

Examiner

Kuo-Liang Peng

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/7/05 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12 and 13 is/are rejected.
- 7) ☒ Claim(s) 10 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The Applicants' amendment filed on October 7, 2005 was received. Claims 1 and 3 are amended. Claims 7-13 are added. Now, Claims 1-13 are pending.
2. Claim rejection(s) under 35 USC 102 and 103 in paragraphs 5 and 7-9 in the previous Office Action (Paper No. 070905) is/are removed.
3. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 070905).

Claim Rejections - 35 USC § 103

4. Rejection of Claims 3-6 under 35 USC 103(a) as being unpatentable over Melancon (US 6 730 397) in view of Schmidt (US 5 248 739), optionally further as evidenced by De Paolo (US 3 509 241) is maintained because the rejection is adequately set forth in paragraphs 8-9 of Paper No. 070905. The newly added Claims 9 and 13 can be rejected, too. Applicant's arguments have been fully

Art Unit: 1712

considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 12, paragraphs 2-6), note that Schmidt does teach the use of an organopolysiloxane in the range of about 800 to 300,000 cps, preferably 10,000 to 100,000 cps. Applicants point out that Schmidt also discloses an organopolysiloxane with a high viscosity up to 100,000,000 mPa.s. However, this high viscosity is based on the neat organopolysiloxane, while the high viscosity of 100,000 mPa.s recited in Claim 3 is a viscosity measured in a 30 wt% solution in toluene. As such, Applicants' organopolysiloxane should have a much higher viscosity in a neat form. (col. 6, lines 1-19) Furthermore, Melancon's HALS reads on Applicants' hindered amine. It should have the same effect as Applicants' hindered amine does. *In re Best*, 195 USPQ 430 (CCPA 1977).

For Applicants' argument (Remarks, page 13, 1st paragraph), note that Examples 1-5 and Table 1 in the specification merely show the unexpected result upon comparing between the specific hindered amine of Compound I, II or a mixture of Compounds I and III; and Compound III along. For Claim 9, the silanol content of Melancon's silicone tackifying resin is described in col. 2, line 66 to col. 3, line 33. For Claim 13, since the composition of Melancon in view of Schmidt is

Art Unit: 1712

substantially the same as that of Applicants', both of them should possess similar properties including the characteristics set forth in the instant claim.

5. Claims 1-2, 7-8 and 12 are rejected under 35 USC 103(a) as being unpatentable over Schmidt (US 5 248 739) in view of Carter (US 2003/0082388).

For Claims 1-2 and 7-8, Schmidt discloses a tape comprising a silicone pressure sensitive adhesive that comprises A) a MQ resin, B) a polydiorganosiloxane containing alkenyl groups, C) a crosslinking agent such as organic peroxides. (col. 1, line 66 to col. 2, line 42, col. 3, line 4 to col. 9, line 2, col. 10, lines 33-44 and Examples) The amount of the peroxide is described in col. 7, lines 14-24. Schmidt the viscosity of the organopolysiloxane is described in col. 6, lines 1-19. The M/Q ratio, the Si-H/Si-alkenyl ratio and the amounts of all components are further exemplified in Examples. The amount of the Si-OH group is described in col. 5, lines 5-16. A stabilizer can be used. Schmidt is silent on the specific stabilizer used. However, Carter teaches the use of a HALS in a silicone composition. The motivation is to stabilizing the silicone composition. ([0004]-[0005] and [0023]-[0028]) In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate Carter's HALS into Schmidt's composition. For Claim 12, since the

Art Unit: 1712

composition of Schmidt in view of Carter is substantially the same as that of Applicants', both of them should possess similar properties including the characteristics set forth in the instant claim.

6. Claims 10-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the above references teaches or fairly suggests the use of the specific hindered amines set forth in the instant claims.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 1712

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

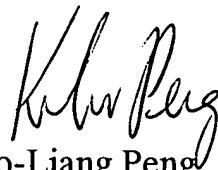
Application/Control Number: 10/721,276

Page 7

Art Unit: 1712

klp

December 24, 2005

A handwritten signature in black ink, appearing to read 'Kuo-Liang Peng', written in a cursive style.

Kuo-Liang Peng
Primary Examiner
Art Unit 1712